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10/604,974	10/29/2003	Robert O'Kane	001-205	1973

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FURR LAW FIRM
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EXAMINER	
NGUYEN BA, HOANG VU A	
ART UNIT	PAPER NUMBER
2421	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/604,974	O'KANE, ROBERT	
	Examiner	Art Unit	
	Hoang-Vu A. Nguyen-Ba	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to Amendment filed September 30, 2008.

2. Claims 3-10 are pending. Claim 3 is an independent claim.

Response to Amendments

3. Per Applicant's request, Claims 1-2 have been canceled and new claims 3-10 have been added.

4. The amendment filed September 30, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: pages 26-42.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. Applicant's cancellation of Claims 1-2 and addition of new claims 3-10 necessitated the new grounds of rejection.

Claim Objection

6. Claims 3, 4, 5 and 6 are objected for the following minor informalities:

Claim 3: at line 4, the redundant comma should be deleted after "content type";

Claim 4: at line 2, "ad's" should be changed to -- ads --;

Claim 5: "DIGITAL TUNER REGULATOR" should be followed by a description noun if the "DIGITAL TUNER REGULATOR" is to be interpreted to be a trademark. Trademark in a claim may be improper unless the trademark is used as an adjective modifying a description noun. For example, it would be appropriate to recite "the JAVA platform" or "the JAVA programming language." Note that in these examples, "platform" and "programming language" provide accompanying generic terminology, describing the context in which the trademark is used. By itself, the trademark JAVA specifies only the source of the so-labeled products, namely SUN Microsystems, Inc.

Claim 6: at line 2, "api's" should be changed to – apis --.

Appropriate correction is required.

Claim Rejections – 35 USC §112

7. The following is a quotation of the second paragraph of the 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 7, 8 and 9 are rejected under 35 U.S.C. §112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3:

at line 4, the limitation "the content owners" lacks proper antecedent basis;

at line 6: the limitation "the viewer" lacks proper antecedent basis;

Claim 7: the limitation "said output device" lacks proper antecedent basis;

Claim 8: the limitation "said output device" lacks proper antecedent basis;

Claim 9: the limitation "said output device" lacks proper antecedent basis.

Claim Rejections – 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 3-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0229900 A1 by Reisman.

It should be noted that hereinafter the use of the clause "see at least" should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant's arguments should not therefore be considered to be that of new grounds of rejection.

Claim 3

Reisman discloses at least *a process comprising:*

having a Digital Tuner Regulator Platform (see at least [0002]) *connected to a two way digital tuner equipped device*(see at least [0112]; [0176]; [0199]; [0235], e.g., PC-DTV) *which regulates the processes which authenticate users, content, advertisement* (see at least [0292]; [0295-0296]), *and royalty distribution* (see at least [0529]; [0616]), *and recognizing and reporting back information about the user* (see at least [0302]; [0369-0370]; [0512]; [0537]), *the times of user activity* (see at least [0189]), *content type* ([0026]), *name of the content* (see at least [0062]), *when it was entered or made available to users by the content owners themselves, the amount of times content has been used or transferred* (see at least FIG. 6; [0029-0030]), e.g., tracking activity; profiling in [0290], [0370]), *the advertisement option* (see at least [0526]; [0616]), *what advertisement the viewer has or has not selected in the past* (see at least [0526]), *the amount of royalties paid for and to whom they were paid* (see at least [0525-0529]).

Claim 4

The rejection of base claim 3 is incorporated. Reisman further discloses *where the activity of the user is one or more of a selection of select/or not select content* (see at least

[0030]; [0115]; [0121-0122]; [0125]), *select or not select ads* (see at least [0115]) *and play or store content* (see at least [0030]; [0073]; [0118]; [0197]; [0306]).

Claim 5

The rejection of base claim 3 is incorporated. Reisman further discloses *generating a DIGITAL TUNER REGULATOR for each unique user* (see at least (see at least [0002]; [0023]).

Claim 6

The rejection of base claim 3 is incorporated. Reisman further discloses *having said information being stored in numerous or stand alone database* (see at least FIG. 1, device 160 or on the iTV/PC), *api's* (see at least [0137]) *or storage units which is controlled by both the actions of the end user's input into the digital tuner equipped device and the Digital Tuner Regulator Platform processes* (see at least FIG. 1, device 160 or on the iTV/PC).

Claim 7

The rejections of the base claim 3 and intervening claim 6 are incorporated. Reisman further discloses *where said database is contained within said output device* (see at least FIG. 1, database stored on iTV's memory to PC; [0118]; [0610]).

Claim 8

The rejection of base claim 3 is incorporated. Reisman further discloses *where said output device is a television* (see at least FIG. 1, device 130).

Claim 9

The rejection of base claim 3 is incorporated. Reisman further discloses *where said output device is a computer* (see at least FIG. 1, 140).

Claim 10

The rejection of base claim 3 is incorporated. Reisman does not specifically disclose *assigning a code for each respective advertisement uploaded by a participating advertiser.*

However, Reisman discloses participation of advertisement authors in [0071]. Thus, the feature of assigning a code for each respective advertisement uploaded by a participating advertiser is deemed inherent to Reisman because without such an identification code, how could content providers keep track of advertisements targeted to customers for customization and billing purposes.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist (571) 272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/
Primary Examiner, Art Unit 2421
February 2, 2009